

ESTTA Tracking number: **ESTTA221955**

Filing date: **07/02/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Avid Technology, Inc.
Granted to Date of previous extension	07/02/2008
Address	One Park West Attn.: Trademark Administrator Tewksbury, MA 01876 UNITED STATES

Correspondence information	Avid Technology, Inc. One Park West Attn.: Trademark Administrator Tewksbury, MA 01876 UNITED STATES trademarks@avid.com
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Applicant Information

Application No	77085148	Publication date	03/04/2008
Opposition Filing Date	07/02/2008	Opposition Period Ends	07/02/2008
Applicant	Guy-Tek, Inc. Suite 3200 811 N. Catalina Avenue Redondo Beach, CA 90277 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Audio/video equipment, namely, jukeboxes, remote terminals with touch screen input for use with jukeboxes, hand-held electronic controllers, and audio/video servers

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1686100	Application Date	01/16/1990
Registration Date	05/12/1992	Foreign Priority Date	NONE
Word Mark	AVID		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1989/06/00 First Use In Commerce: 1989/06/00 computer hardware; namely, computers, video digitizers, audio digitizers, analog to digital audio converters, National Television Standard Code to Red-Green-Blue synchronization video and audio signal converters, video and signal converters, synchronization generators, video local area network controllers, video monitor controllers, monitors; computer programs for use in video editing

U.S. Registration No.	3154131	Application Date	12/30/2005
Registration Date	10/10/2006	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1989/06/00 First Use In Commerce: 1989/06/00 Apparatus for recording, transmission or reproduction of sound and images; Cables and fibres for the transmission of sounds and images; Computer peripherals; Computer programs for editing images, sound and video; Computer software for processing digital music files; Computer software for use in relation to digital animation and special effects of images; Loudspeakers; Microphones; Music-composition software; Sound mixers		

U.S. Registration No.	3403236	Application Date	12/30/2005
Registration Date	03/25/2008	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 015. First use: First Use: 2004/08/00 First Use In Commerce: 2004/08/00 Keyboard instruments		

U.S. Registration No.	3304280	Application Date	12/30/2005
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 Books in the field of audio, video, film, music, and computers; manuals in the field of audio, video, film, music, and computers; pencils; pens; writing pads		

U.S. Registration No.	3304281	Application Date	12/30/2005
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Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2000/00/00 First Use In Commerce: 2000/00/00 Backpacks; carrying cases; duffle bags; luggage tags		

U.S. Registration No.	3304282	Application Date	12/30/2005
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2000/00/00 First Use In Commerce: 2000/00/00 Bottles, sold empty; cups; mugs		

U.S. Registration No.	3304283	Application Date	12/30/2005
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 Headwear; jackets; shirts		

U.S. Registration No.	3304284	Application Date	12/30/2005
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 Installation of computer networks; Installation of computer systems		

U.S. Registration No.	3154132	Application Date	12/30/2005
Registration Date	10/10/2006	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 042. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 Design, development and implementation of software; Installation of computer software; Technical support services, namely, troubleshooting of computer hardware and software problems

U.S. Registration No.	3154133	Application Date	12/30/2005
Registration Date	10/10/2006	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 Computer education training services; Training services in the field of editing sounds and images, animation, and special effects		

U.S. Registration No.	3083619	Application Date	04/15/2004
Registration Date	04/18/2006	Foreign Priority Date	NONE
Word Mark	AVID DNXHD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/09/00 First Use In Commerce: 2004/09/00 data compression software, namely, an audio video codec		

U.S. Application No.	77217843	Application Date	06/28/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: Business consulting and information services; Business research and surveys; On-line retail store services featuring computer hardware, computer software, peripherals, musical instruments, audio equipment, and video equipment; Operation of a business for others; namely, operating media, entertainment, or information technology facilities; Outsourcing in the field of media, entertainment, and information technology		

U.S. Application No.	77163904	Application Date	04/24/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AVID		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 038. First use: Communication via fibre optical networks; Telecommunications consultation; Transfer of data by telecommunication

U.S. Application No.	77217845	Application Date	06/28/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	AVID
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 041. First use: Consulting services in the fields of media and entertainment; Magazine publishing; Entertainment services, namely, providing a Web site featuring video and music downloads; On-line journals, namely, blogs featuring media, entertainment, and information technology topics; Providing on-line training courses in the field of media, entertainment, and information technology
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/daniel l. scales/
Name	Daniel L. Scales
Date	07/02/2008

Statement of Claim

Avid Technology, Inc., (“Avid”) a Delaware corporation with headquarters at Avid Technology Park, One Park West, Tewksbury, Massachusetts 01876, believes that it will be damaged by the registration of the following application by Guy-Tek, Inc. (“Applicant”), and opposes registration of this application:

<u>Mark</u>	<u>Serial No.</u>	<u>Application Date</u>
AVED	77/085,148	January 17, 2007

As grounds for the opposition, Avid alleges the following:

Avid’s Business and the AVID brand

1. Avid is a world leader and industry standard in digital media tools for film, video, audio, animation, games, and broadcast professionals, as well as for home video and home audio enthusiasts. Today in the United States, the vast majority of primetime television shows, feature films, commercials, and music hits are made using one or more Avid products.

2. Since its founding in 1987, Avid has used the AVID mark as a trade name for its business and since at least as early as 1989 as a trademark in connection with its marketing and sale of a wide variety of products and services.

3. Avid has received extensive recognition for its high quality and innovative products. For example, Avid has received the most prestigious awards in the television, music, and film industries, including three Emmys, a Grammy, and two Oscar statuettes.

4. Avid has spent substantial effort and expense in promoting its “AVID” mark and the goods and services offered in connection with the mark, with the result that the purchasing

public has come to know and rely upon it. Avid has exceedingly valuable goodwill established in its mark.

5. Avid owns the following United States trademark registrations for the AVID mark and related marks:

- **AVID**: Incontestable trademark Registration Number 1,686,100, issued on May 12, 1992 for “computer hardware; namely, computers, video digitizers, audio digitizers, analog to digital audio converters, National Television Standard Code to Red-Green-Blue synchronization video and audio signal converters, video and signal converters, synchronization generators, video local area network controllers, video monitor controllers, monitors; computer programs for use in video editing.” (class 9)
- **AVID**: Trademark Registration Number 3,154,131, issued on October 10, 2006 for “apparatus for recording, transmission or reproduction of sound and images; cables and fibers for the transmission of sounds and images; computer peripherals; computer programs for editing images, sound and video; computer software for processing digital music files; computer software for use in relation to digital animation and special effects of images; loudspeakers; microphones; music-composition software; sound mixers.” (class 9)
- **AVID**: Trademark Registration Number 3,403,236, issued on March 25, 2008 for “Keyboard instruments.” (class 15)
- **AVID**: Trademark Registration Number 3,304,280, issued on October 2, 2007 for “books in the field of audio, video, film, music, and computers; manuals in

the field of audio, video, film, music, and computers; pencils; pens; writing pads.” (class 16)

- **AVID**: Trademark Registration Number 3,304,281, issued on October 2, 2007 for “backpacks; carrying cases; duffle bags; luggage tags.” (class 18)
- **AVID**: Trademark Registration Number 3,304,282, issued on October 2, 2007 for “bottles, sold empty; cups; mugs.” (class 21)
- **AVID**: Trademark Registration Number 3,304,283, issued on October 2, 2007 for “headwear, jackets; shirts.” (class 25)
- **AVID**: Trademark Registration Number 3,304,284, issued on October 2, 2007 for “installation of computer networks; installation of computer systems.” (class 37)
- **AVID**: Trademark Registration Number 3,154,133, issued on October 10, 2006 for “computer education training services; training services in the field of editing sounds and images, animation, and special effects.” (class 41)
- **AVID**: Trademark Registration Number 3,154,132, issued on October 10, 2006 for “design, development and implementation of software; installation of computer software; technical support services, namely, troubleshooting of computer hardware and software problems.” (class 42)
- **AVID DNXHD**: Trademark Registration Number 3,083,619, issued on April 18, 2006 for “data compression software, namely, an audio video codec.” (class 9)

6. Avid owns a number of pending United States trademark applications for the AVID mark and related marks for other goods and services:

- **AVID**: Pending trademark application number 77/217,843, for “Business consulting and information services; Business research and surveys; On-line retail store services featuring computer hardware, computer software, peripherals, musical instruments, audio equipment, and video equipment; Operation of a business for others; namely, operating media, entertainment, or information technology facilities; Outsourcing in the field of media, entertainment, and information technology” (class 35), filed on June 28, 2007.
 - **AVID**: Pending trademark application number 77/163,904, for “Communication via fibre optical networks; Telecommunications consultation; transfer of data by telecommunication” (class 38), filed on April 24, 2007.
 - **AVID**: Pending trademark application number 77/217,845, for “Consulting services in the fields of media and entertainment; Magazine publishing; Entertainment services, namely, providing a Web site featuring video and music; On-line journals, namely, blogs featuring media, entertainment, and information technology topics; Providing on-line training courses in the field of media, entertainment, and information technology” (class 41), filed on June 28, 2007.
7. Applicant has filed the following applications:
- **AVED**: Pending trademark application number 77/085,148 for “Audio/video equipment, namely, jukeboxes, remote terminals with touch screen input for use with jukeboxes, hand-held electronic controllers, and audio/video servers.” (class 9)

8. Applicant and Avid entered into an agreement on July 2, 2008, whereby Applicant agreed to amend its identification of goods in trademark application 77/085,148. Applicant petitioned the Commission of Trademarks on July 1, 2008 to amend the identification of goods in trademark application 77/085,148 in accordance with such agreement. As of the time of this filing, the publicly available USPTO databases do not show that the requested amendment has been accepted.

9. If the amendment to trademark application 77/085,148 referred to in Paragraph 8 above is not accepted, Applicant's mark so resembles Avid's "AVID" and "AVID DNXHD" marks as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

10. If the amendment to trademark application 77/085,148 referred to in Paragraph 8 above is not accepted, Applicant's mark falsely suggest a connection with Avid in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

11. Avid's AVID mark is distinctive and famous, and was so before Applicant filed its application.

12. If the amendment to trademark application 77/085,148 referred to in Paragraph 8 above is not accepted, Applicant's use or registration of the mark as shown in its application will dilute the distinctive quality of Avid's "AVID" mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

13. If the amendment to trademark application 77/085,148 referred to in Paragraph 8 above is not accepted, Applicant's registration of the mark "AVED" on the Principal Register of the United States Patent and Trademark Office would cause injury and damage to Avid.

Therefore, if the amendment to trademark application 77/085,148 referred to in Paragraph 8 above has not yet been accepted, Avid requests that this opposition be sustained and that registration of Applicant's marks be refused.